

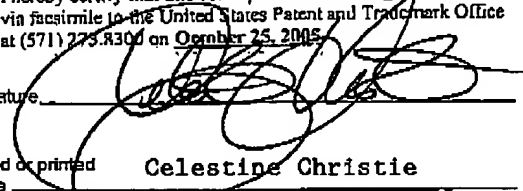

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<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional) <b>CONTIC. 52380</b>	
<b><u>CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8</u></b> I hereby certify that this correspondence is being transmitted via facsimile to the United States Patent and Trademark Office at (571) 273-8300 on <u>October 25, 2005</u> . Signature:  Typed or printed name: <u>Celestine Christie</u>		Application Number <b>09/933,229</b>	Filed <b>August 20, 2001</b>
		First Named Inventor <b>Kenneth N. Harel</b>	
		Art Unit <b>3637</b>	Examiner <b>Phi D. Tran A.</b>
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.  This request is being filed with a notice of appeal.  The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/98) <input checked="" type="checkbox"/> attorney or agent of record. <b>24,649</b> Registration number _____ <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____		 Signature <b>Vern Schooley, Esq.</b> Typed or printed name <b>(562) 432-0453</b> Telephone number <b>October 25, 2005</b> Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.			
<input checked="" type="checkbox"/> *Total of <u>1</u> forms <sup>is</sup> submitted. - with <u>5</u> attached sheets of Argument/Remarks.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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OCT 25 2005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 09/933,229 Conf. No. 6394  
Applicant : Kenneth N. Harel  
Filed : August 20, 2001  
Art Unit : 3637  
Examiner : Phi D. Tran A.  
  
Docket No.: : CONTC.57582  
Customer No. : 27629

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Dear Sir:

Under the provisions of the Pre-Appeal Brief Conference Pilot Program, as set forth in the Notice included in the July 12, 2005 Official Gazette (Vol. 1296), Applicant requests review by a panel of Examiners of the claim rejections of record in this matter. Claims 15-16, 30, 35-36, 41-48 and 52-55 remain pending, all of which the Examiner has rejected for alleged obviousness over U.S. Patent Nos. 6,295,776 to Kunz (hereinafter "Kunz") or 5,131,198 to Ritchie et al. (hereinafter Ritchie) in view of 2,853,871 to Compton (hereinafter "Compton") and RE34,547 to Weldy (hereinafter "Weldy").

Applicant respectfully believes that the present situation is appropriate for panel review because the Examiner has failed to show any motivation in the art to combine his cited references to arrive at Applicants invention, nor any expectation that such a combination would be successful. His rejections are predicated upon an erroneous characterization of Compton, and cannot provide adequate support for discharging his burden of showing *prima facie* obviousness. In accordance with the program requirements, and in view of the Examiner's unjustifiable intractability in this instance, Applicant is also filing concurrent herewith a Notice of Appeal.

As set forth throughout the intrinsic record, for example at page 3 of Applicant's Amendment filed February 24, 2003, Applicant's corner bead invention incorporates a two part construction. First, there is a relatively rigid core, which is typically metal. The core is covered with a paper covering which projects laterally from at least one side edge of the core to form a flexible flap or flaps. The manufacturing process forms parallel grooves and ribs along the flap(s). The ribs, when embedded in joint compound applied to underlying drywall panel, cooperate to anchor the bead securely in place.

In an Office Action dated December 1, 2003, the Examiner rejected the majority of Applicant's pending claims as obvious based on a combination of Kunz, Weldy and U.S. Patent Nos. 1,586,018 to Westberg and 2,012,203 to Peterson. Applicant then, in an Amendment dated March 1, 2004, responded in detail, pointing to the fact that each independent claim recited projections, or ridges, being formed on at least the inwardly-facing surface of the flap (see pages 21-22 of March 1, 2004 Amendment) and that these cited references did not provide a motivation to combine them to arrive at this aspect of Applicant's invention (see pages 26-47). These general structural limitations remain in each of the presently pending independent claims. The panel will note the Examiner relied on the Peterson patent to provide such ridges on the inward surface of a flap. However, Peterson discloses an expansion joint constructed entirely of an uncovered sheet of stamped or pressed metal (see Applicant's arguments at pages 29-31), and accordingly cannot include a paper covering forming flaps because it would rupture during the expansion of the joint.

In an Office Action dated June 4, 2004, after considering Applicant's arguments, the Examiner allowed almost all of the pending claims. His indication of allowable material, which the panel will find detailed on page 3 of the Office Action, reveals the Examiner was in agreement that the prior art does not teach ridges being formed on at least the inwardly-facing surface of the flap for embedding in compound.

However, in an inexplicable development, on November 2, 2004, the Examiner issued an Office Action withdrawing his indication of allowance for all claims based on

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newly discovered U.S. Patent No. 6,295,776 to Compton (hereinafter "Compton"). In rejecting each of the pending claims, the Examiner admitted that neither Kunz nor Ritchie taught ridges on the inward surface of the flap for embedding in joint compound (see e.g. pages 3-5, 7). In each instance, the Examiner this time asserted the missing limitation was found in the Compton reference.

As Applicant has pointed out, starting at page 10 of the responsive Amendment filed on May 4, 2005, Compton is directed to a metallic expansion joint for use with heat insulation covers such as those surrounding hot water tanks or steam pipes. Specifically, his "joint structure" is used in connection with "insulating bricks or slabs 15 . . . applied to the exterior surfaces of containers . . . that are heat insulated." [Compton patent, Col. 1, lines 65-68]. Compton explains that calking material interposed between the blocks of this type of construction will not hold up in the "wide range of expansion and contraction . . . under repeated temperature changes." [*Id.* at Col. 1, line 68 – Col. 2, line 1]. Compton's device, therefore, includes "a sheet metal cap strip 16 bent to bead form at 17 and aligning pins 18 . . . for telescopic connection with beads of adjacent strips . . . Additional folds or bends 19 are provided in the strip and have wing-like extensions 20 that are foraminous or mesh form . . . these wings being embedded in plastic insulation covering as shown more clearly in Fig. 8." [*Id.* at Col. 2, lines 15-27]. Compton further explains "staples 24 can be driven through the wings to hold the strips and blocks in place for the application of the covering 21 of plastic material." [*Id.* at Col. 2, lines 32-35].

As the panel can appreciate, Compton includes neither flaps nor ridges on flaps, and his metal wings are secured by staples and embedded in plastic insulation rather than overlying joint compound on a drywall panel. Compton fails to suggest applicants claimed results because it relates to expansion joints for use with heat-insulating covers on hot-water tanks and the like, and does not seek to solve a similar problem. Thus, Applicant respectfully submits that Compton is at least equally as inappropriate for demonstrating *prima facie* obviousness as was the Peterson patent.

Therefore, in the May 4, 2005 Amendment, Applicant asserted the Examiner failed to show that Compton teaches ridges on the inward facing surface of the flap formed by a cover extending past the edge of a core, and correctly asserted the Examiner's conclusory statements were insufficient to demonstrate a motivation to combine or modify the prior art to arrive at Applicant's invention (see e.g. pages 10-12). In his responsive Office Action, dated July 29, 2005, the Examiner reasserted his conclusory rejections without taking the opportunity to demonstrate a motivation or suggestion in the prior art, or those of skill in the art, to combine Compton with Kunz.

In view of the foregoing, and of the fact that the Examiner has already once deemed the pending claims allowable for good reason over the prior art because it "does not show the inward facing surface of the flap having ridges . . . " and "does not provide sufficient motivation to modify Kunz to show the inner surface of the flap having ridges" [Reasons for Allowance, Office Action dated June 4, 2004, page 3], it is believed the Examiner has failed to carry his burden. To sustain the Examiner's claim rejections in this instance, the panel would be required to conclude that Compton's expansion joint includes ridges for embedding in joint compound, which the Examiner admits are absent in Kunz, and that there is a motivation to combine with Kunz to form such ridges on the inward facing surface of a flap. In fact, Applicant has demonstrated that Compton actually teaches away from a combination with Kunz as the resultant structure would not work for its intended purposes (see May 4, 2005 Amendment, page 11). The evidence is that it was not obvious to Kunz as he proposed no such structure until his application of September 28, 2001 for U.S. Patent No. 6,539,680 (see August 23, 2001 Amendment, bottom of page 19).

In the July 29, 2005 Office Action, the Examiner asserts that "Compton shows flaps (20) having elongated grooves and ridges with at least the inward surfaces including the ridges for anchoring the joint compound (21) . . . " This statement on page 3 is exemplary of the Examiner's reliance on Compton for all rejections. Because he has provided no element numbers, Applicant is respectfully at a loss as to where the

Examiner finds "grooves and ridges" on the alleged flaps of Compton. This is especially baffling in light of the fact that Compton does not include a paper-type cover adhered to the outside surface of a core, and accordingly cannot be said to include flaps.

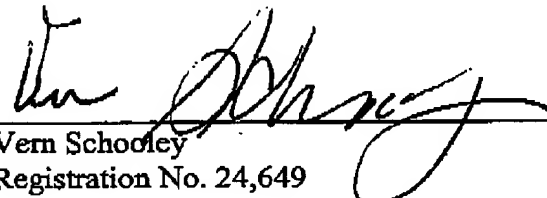
Again, the reason for this is self-evident. As stated in M.P.E.P. § 2143.01, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990). If Compton incorporated a paper covering over his expansion joint, the covering would tear and rupture under Compton's self-described "wide range of expansion and contraction . . . under repeated temperature changes," thus failing to work for its intended purpose. As M.P.E.P. § 2143.01 further explains, "[i]f the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." (citing *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984)). Such is the case in this instance.

In view of the foregoing, Applicant respectfully submits that the Examiner has failed to demonstrate *prima facie* obviousness and asks that the presently pending rejections be withdrawn and the claims be allowed to advance to issuance. The claims have already been allowed once over all prior art of record except Compton, and the Examiner's reliance on the new found Compton reference cannot support his unexpected and unjustified withdrawal of this allowance.

Respectfully submitted,

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